

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed March 30, 2010. At the time of the Office Action, Claims 1-18 were pending in this Application. Claims 1-18 were rejected. Claims 4, 5, 9-12 and 14-17 have been amended. Claims 1-3, 6-8, 13 and 18 have been canceled without prejudice or disclaimer. New Claims 19-28 have been added. Applicant respectfully requests reconsideration and favorable action in this case.

Claim Objections

Claims 8, 13 and 14 were objected due to the recitation of certain phrases, which the Examiner recommended be replaced with alternative language. Claim 14 has been amended, and Claims 8 and 13 have been canceled.

Rejections under 35 U.S.C. § 102

Applicant respectfully traverses the rejections and submits that the art reference relied upon does not disclose, expressly or inherently, all of the elements and limitations of independent Claims 19 and 27, and claims dependent thereto.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “the identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that the cited art as anticipated by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

Claims 1, 3, 6 and 9 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,644,368 issued to Gerhard Mutz ("*Mutz*")

The *Mutz* reference discloses a tachograph printer that uses input keys to define information to be printed on a paper sheet. The paper sheet of the *Mutz* reference does not disclose a "print configuration design" for defining a "desired print configuration" that the printer will use to print information on a print medium, as claimed in independent Claims 19 and 27. The present invention is distinctly different from the *Mutz* reference because in the claimed invention the configuration design information is read from the print medium and used by the printer to automatically format what will be printed on the print medium. The *Mutz* reference fails to disclose this feature, expressly or inherently.

Therefore, the *Mutz* reference does not disclose, expressly or inherently, "at least one sensor for reading a print configuration design associated with the print medium, wherein the print configuration design specifies a desired print configuration used by the printing unit; and a control unit coupled to the printing unit, the conveying unit and the at least one sensor, wherein the control unit determines from the at least one sensor the print configuration design associated with the print medium, whereby the control unit applies the desired print configuration to a specific content of a printout that is printed onto the print medium" as recited in independent Claim 19.

Similarly, the *Mutz* reference does not disclose, expressly or inherently, "reading a print configuration design on the print medium with at least one sensor, wherein the print configuration design specifies a desired print configuration used by the printing unit; determining from the at least one sensor the print configuration design on the print medium with a control unit; and printing a specific content of a printout onto the print medium using the desired print configuration according to the print configuration design determined with the control unit" as recited in independent Claim 27.

Claim 1 has been canceled and replaced with new Claim 19. Claims 3 and 6 have been canceled.

Claim 9 depends from new independent Claim 27 and contains all elements and limitations thereof. Thus for at least the same reasons that Claim 27 is allowable, Claim 9 is also allowable.

Rejections under 35 U.S.C. §103

Applicant respectfully traverses the rejections and submits that the references relied upon do not teach or suggest, individually or in combination, what is recited in independent Claims 19 and 27, and all claims dependent thereto.

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on ex post reasoning. *KSR*, 127 S.Ct. at 1742. In addition, evidence that such a combination was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), citing *KSR*, 127 S.Ct. at 1741.

Claims 2, 8 and 13-15 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Mutz* in view of U.S. Patent Application No. 6,633,393 (“*Fukano*”)

Claims 2, 8 and 13 have been canceled.

The *Mutz* reference has been discussed more thoroughly hereinabove under the § 102 rejections, and is incorporated by reference herein regarding the following § 103 rejections.

The *Fukano* reference teaches a printer that can detect which side of a preprinted print medium, *e.g.*, a check, is exposed to the printing means of the printer, thereby automatically printing data to the correct side of the print medium. In addition to detection of which side is exposed to the printing area, the orientation (direction) of the print medium is determined. If there is an error in the direction of insertion of the print medium, the print medium will be ejected out the same slot that it was inserted until a proper orientation is achieved. The side detection is used to determine what should be printed on the face of the print medium facing the printing means once its orientation is determined to be correct (for either side). Applicant respectfully submits that the *Fukano* reference fails to teach or suggest determining a desired print configuration that will be used by the printing unit based upon reading of a print configuration design associated with the print medium, *e.g.*, the printer reads print configuration (design) information from the print medium then prints data on the print medium based upon the read configuration design information. The present invention is distinctly different from the references relied upon because in the claimed invention the configuration design information is read from the print medium and used by the printer to automatically format what will be printed on the print medium. The references relied upon fail to teach or suggest this feature.

The *Fukano* reference fails to teach or suggest, individually or in combination with the *Mutz* reference, “at least one sensor for reading a print configuration design associated with the print medium, wherein the print configuration design specifies a desired print configuration used by the printing unit; and a control unit coupled to the printing unit, the conveying unit and the at least one sensor, wherein the control unit determines from the at least one sensor the print configuration design associated with the print medium, whereby the control unit applies the desired print configuration to a specific content of a printout that is printed onto the print medium” as recited in independent Claim 19.

Claims 14 and 15 depend from Claim 19 and contain all limitations and elements thereof. Thus for at least the same reasons that Claim 19 is allowable, Claims 14 and 15 are also allowable.

Claims 4, 5, 7, 10 and 12 were rejected under 35 U.S.C. §103(a) as being unpatentable over Mutz in view of U.S. Patent Application Publication No. 2001/0045452 (“*Momose*”)

Claim 7 has been canceled.

The *Momose* reference teaches a combination printer and MICR check information reader. However, *Momose* fails to teach or suggest reading a print configuration design associated with the print medium, wherein the print configuration design specifies a desired print configuration used by the printing unit. The *Momose* reference may teach reading MICR magnetic ink characters on a bank check, but there is no teaching or suggestion in the *Momose* reference that reading magnetic ink characters on a bank check affects the print configuration of a printout.

Therefore, the *Momose* reference fails to teach or suggest, individually or in combination, with the other references relied upon “at least one sensor for reading a print configuration design associated with the print medium, wherein the print configuration design specifies a desired print configuration used by the printing unit; and a control unit coupled to the printing unit, the conveying unit and the at least one sensor, wherein the control unit determines from the at least one sensor the print configuration design associated with the print medium, whereby the control unit applies the desired print configuration to a specific content of a printout that is printed onto the print medium” as recited in independent Claim 19.

Claims 4, 5, and 10 depend from Claim 19 and contain all limitations and elements thereof. Thus for at least the same reasons that Claim 19 is allowable, Claims 4, 5 and 10 are also allowable.

Claim 11 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Mutz* in view of *Fukano* and *Momose*

As discussed more fully herein, none of the references relied upon teach or suggest, individually or in combination, “reading a print configuration design on the print medium with at least one sensor, wherein the print configuration design specifies a desired print configuration used by the printing unit; determining from the at least one sensor the print configuration design on the print medium with a control unit; and printing a specific content

of a printout onto the print medium using the desired print configuration according to the print configuration design determined with the control unit” as recited in independent Claim 27.

Claim 11 depends from Claim 27 and contains all limitations and elements thereof. Thus for at least the same reasons that Claim 27 is allowable, Claim 11 is also allowable.

Claim 16 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Mutz* in view of *Fukano* and further in view of U.S. Patent No. 6,392,677 (“*Lais*”)

The *Lais* reference fails to teach or suggest, individually or in combination, with the other references relied upon “at least one sensor for reading a print configuration design associated with the print medium, wherein the print configuration design specifies a desired print configuration used by the printing unit; and a control unit coupled to the printing unit, the conveying unit and the at least one sensor, wherein the control unit determines from the at least one sensor the print configuration design associated with the print medium, whereby the control unit applies the desired print configuration to a specific content of a printout that is printed onto the print medium” as recited in independent Claim 19.

Claim 16 depends from Claims 15 and 19 and contains all limitations and elements thereof. Thus for at least the same reasons that Claim 15 and 19 are allowable, Claim 16 is also allowable.

Claims 17-18 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Mutz* in view of *Fukano* and further in view of U.S. Patent Application Publication No. 2005/0134673 (“*Bendek*”)

Claim 18 has been canceled.

The *Bendek* reference fails to teach or suggest, individually or in combination, with the other references relied upon “at least one sensor for reading a print configuration design associated with the print medium, wherein the print configuration design specifies a desired print configuration used by the printing unit; and a control unit coupled to the printing unit, the conveying unit and the at least one sensor, wherein the control unit determines from the at least one sensor the print configuration design associated with the print medium, whereby the

control unit applies the desired print configuration to a specific content of a printout that is printed onto the print medium” as recited in independent Claim 19.

Claim 17 depends from Claim 19 and contains all limitations and elements thereof. Thus for at least the same reasons that Claim 19 is allowable, Claim 17 is also allowable.

No Basis or Support has been Shown in the Rejections of the Claims that One Having Ordinary Skill in the Art at the Time of Applicant’s Invention Would be Motivated to Modify the References Relied Upon to Produce the Invention

Applicant respectfully traverses the rejections asserted in the office action based upon “it would have been obvious [or readily apparent] to one of ordinary skill in the art at the time of the Applicant’s invention” the various elements found in the references relied upon to produce the present invention. See, *e.g.*, pages 5-14 of the instant office action.

Pursuant to MPEP § 2144.03, incorporated by reference herein for all purposes, Applicant respectfully submits that no prior art reference documents have been disclosed nor asserted that would substantiate that one having ordinary skill in the art at the time of Applicant’s invention would be motivated to modify the references relied upon to produce the present invention. Furthermore, Applicant respectfully submits that the references relied upon do not teach or suggest, individually or in combination, the new, novel and non-obvious advantages of what is recited in independent Claims 19 and 27 and all claims dependant thereto.

Request for Evidentiary Support

Should a rejection based on any of the above asserted rejections be maintained, Applicant respectfully requests appropriate evidentiary support. Additionally, if the Examiner is relying upon “common knowledge” or “well known” principles to establish the rejection, Applicant respectfully requests that a reference be provided in support of this position pursuant to MPEP § 2144.03. Furthermore, to the extent that the Examiner maintains any rejection based on an “Official Notice” or other information within the Examiner’s personal knowledge, Applicant respectfully requests that the Examiner cite a reference as documentary evidence in support of this position or provide an affidavit in accordance with MPEP § 2144.03 and 37 C.F.R. 1.104(d)(2).

No Waiver

All of Applicant's arguments and amendments are without prejudice or disclaimer. Additionally, Applicant has merely discussed example distinctions from the references relied upon. Other distinctions may exist, and Applicant reserves the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicant are sufficient to overcome the rejections asserted in the present Office Action.

CONCLUSION

Applicant has made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicant respectfully requests reconsideration of the pending claims.

Applicant believes that there are no fees due at this time. However, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-4871 of King & Spalding L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512-457-2030.

Respectfully submitted,
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Date: 6/21/10

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